

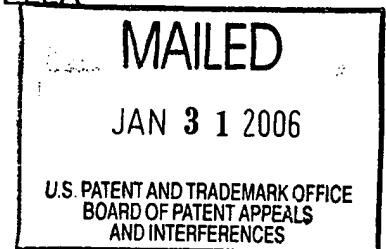
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte HELEN HARDMAN HOWLETT-CAMPANELLA

Appeal No. 2005-1953
Application No. 09/765,533



ON BRIEF

Before GARRIS, PAK, and JEFFREY T. SMITH, Administrative Patent Judges.
JEFFREY T. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3-23, the only pending claims. (Brief, p. 2). We have jurisdiction under 35 U.S.C. § 134.

BACKGROUND

The present invention relates to a mat comprising a symmetrical body placement guide on the upper surface. According to Appellant, “[t]he present invention resides in a yoga mat which allows a practitioner to properly align his or her body in a variety of poses as well as tracking his or her flexibility progress. The yoga mat generally comprises an elongated mat having an upper and a lower surface. In a particularly preferred embodiment of the invention, the elongated mat has a rectangular configuration. A symmetrical body placement guide is imprinted on the upper surface of the mat and configured to aid the yoga practitioner to properly align the practitioner's body during yoga postures.” (Brief, p. 4). Appeal claim 1 is reproduced below:

1. A yoga mat, comprising:

an elongated mat having an upper surface and a lower surface; and a symmetrical body placement guide on the upper surface of the mat and configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures, the body placement guide including:

a patterned design defining a longitudinal axis substantially extending the length of and bisecting the upper surface, the patterned design further defining a transverse axis bisecting the longitudinal axis, and indicia positioned from the longitudinal axis at a forty-five degree angle; and

four equal quadrants defined by the longitudinal axis and the transverse axis, each quadrant being adjacent to two other quadrants, the patterned design in each quadrant being a mirror image of the patterned design of the two adjoining quadrants.

The Examiner relies on the following reference in rejecting the appealed claims:

Dionne et al. (Dionne) 5,645,494 Jul. 08,1997

The Examiner rejected claim 23 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner also rejected the subject matter of claims 1 and 3 to 23 under 35 U.S.C. § 103(a) over Dionne. (Office Action mailed May 14, 2003, pp. 2-4). We affirm the rejection of claim 23 under 35 U.S.C. § 112, first paragraph and the rejection of claims 1, 4, 6-18, 21 and 22 under 35 U.S.C. § 103(a). However, the rejection of claims 3, 5, 19 and 23 under 35 U.S.C. § 103(a) is reversed.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellant regarding the above-noted rejections, we make reference to the Answer (mailed October 6, 2004) and the Office Action mailed May 14, 2003 for the Examiner's reasoning in support of the rejection, and to the Briefs (filed October 6, 2003, February 11, 2004 and November 08, 2004) for the Appellant's arguments there against.

OPINION

Rejection under 35 U.S.C. § 112

It is well settled that a specification complies with the 35 U.S.C. § 112, first paragraph, written description requirement if it conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention. See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

It is the Examiner's position that subject matter of claim 23 is not described in the specification.¹ (Answer, p. 6).

In response to this rejection, Appellant has argued and presented two declarations² to establish that "markers" are described in the drawings of the present specification and the provisional applications.³ Appellant argues that the indicia 54, 56

¹Specifically, the Examiner asserts that subject matter appearing in lines 10-18 of claim 23 is not described in the specification.

² Appellant presented the declaration of Campanella and the declaration of Ferris. (Attached to the Brief as exhibits F and G respectively).

³ Application numbers 60/177,512 and 60/229,868.

and 58 located at the points of intersection of the first lines and second lines are markers.⁴

While the points identified by Appellant may be identified as markers, this does not entirely address the issue presented by the Examiner in the rejection of claim 23.⁵ The Examiner questioned the support for the subject matter as a whole appearing in claim 23. Specifically, the Examiner found that there is no descriptive support for the intersecting lines define rectangles wherein the plurality of rectangles are separated into **six non-overlapping sets of four quadrants defining a unit area** on opposing sides of said second center line wherein each set of four quadrants has a center point, much less a combination of such rectangles and a plurality of markers.

⁴ See Appellant's response filed August 19, 2002, attached to the Brief as exhibit C.

⁵Claim 23 is reproduced below:

23. A yoga mat, comprising:
a mat comprised of a flat structure having an upper surface, a lower surface and a longitudinal axis;
a first center line positioned upon said upper surface of said mat;
a second center line positioned upon said upper surface of said mat parallel to said longitudinal axis and orthogonal with respect to said first center line; wherein said second center line intersects said first center line;
a plurality of first lines parallel to said first center line;
a plurality of second lines parallel to said second center line;
wherein said first center line, said second center line, said plurality of first lines and said plurality of second lines provide a plurality of rectangles upon said mat, wherein said plurality of rectangles are separated into six non-overlapping sets of four quadrants defining a unit area on opposing sides of said second center line wherein each set of said four quadrants has a center point; and
a plurality of markers wherein a single marker is located on selected intersections of said plurality of second lines with said first line and at each said center point of each set of four quadrants.

Appellant argues "a review of the figures of the provisional and non-provisional applications clearly show the circular indicia identified by markers 54, 56, and 58 as well as the plurality of rectangles separated into six non-overlapping sets (e.g., FIG. 8 shows rectangles (unnumbered) with 90 degree corners and sides formed by the intersections of broken lines 30, 32, 48 et al with each other and with the edge of the mat)." (Reply Brief filed February 11, 2004, p. 2). Appellant relies on a "marked up" figure 8 (a new drawing submitted after the original application was filed) to show the features of claim 23. Specifically Appellant states:

A marked up version of FIG. 8 (with the lines forming the sides of the rectangles completed in phantom) has been provided for the purpose of providing clarity and is attached hereto in the Appendix as Exhibit "A". As seen in the marked-up figure, a first center line 32 is positioned on the upper surface of the mat. A second center line 30 is positioned on the upper surface of the mat orthogonal with respect to the first center line 32. The second center line 30 intersects the first center line 32. A plurality of first lines are shown parallel to the first center line 32.

A plurality of second lines are shown parallel to the second center line 30.

The first center line 32, the second center line 30, and the plurality of first lines and the plurality of second lines provide a plurality of rectangles on the mat which are separated into six (A, B, C, D, E, F) non-overlapping sets of four quadrants (I, II, III, IV) which define a unit area on opposing sides of the second center line. The 90 degree corners and sides of the rectangles/quadrants are formed by the intersections of broken lines 30, 32, 48 et al with each other and with the edge of the mat.

Each set of the four quadrants (I, II, III, IV) has a center point. The figure also shows a plurality of markers and that a single marker is located on selected intersections of the plurality of second lines with the plurality of first lines and at each center point of each set of four quadrants.

(Reply Brief, filed February 11, 2004 page 22)

The written description requirement of § 112, first paragraph, entitles the Appellant to claim only that which is described in the application, and does not extend to subject matter which is not described, but would be obvious over what is expressly disclosed. Cf. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991) ("[T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed."). In the present case, Appellant has not directed us to evidence in the specification, as originally filed, or in the provisional applications that describes the lines added to the "marked up" figure 8 to form the claimed rectangles. We have not been directed to portions of the record that explain why the lines (of only figure 8) should be extended to connect so as to form the claimed rectangles.⁶ While it might have been obvious to extend the lines as Appellant has presented in "marked up" figure 8 this is not the proper standard for determining if the record provides an adequate written disclosure. In view of the above, the application as originally filed and the provisional applications do not provide descriptive support for claim 23 in the manner provided for in the first paragraph of § 112.

⁶ Appellant has not directed us to portions of the record which discloses that the first lines and second lines of figure 8 should be extended but not the diagonal lines contained therein.

Rejection under 35 U.S.C. § 103(a)

Upon careful review of the respective positions advanced by Appellant and the Examiner, we affirm for the reasons advanced by the Examiner and add the following primarily for emphasis.

Our initial inquiry is directed to the scope of the claimed subject matter. During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, and the claim language is to be read in view of the specification as it would be interpreted by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976).

In the present case, Appellant explains that mats can be used in types of yoga, including Hatha Yoga. Appellant describes the simplest form of yoga as “moving one’s body in seven possible one-movement directions and in varying combinations of those movements.” (Specification, p. 1). Appellant discloses that the invention is directed to a universally useable yoga mat which aids the practitioner in properly aligning himself or herself in various poses and which allows the practitioner to determine his or her flexibility.” (Specification, p. 3).

The specification, pages 3-4, describes Appellant's invention as follows:

The present invention resides in a yoga mat which allows a practitioner to properly align his or her body in a variety of poses as well as tracking his or her flexibility progress. The yoga mat generally comprises an elongated mat having an upper and a lower surface. In a particularly preferred embodiment of the invention, the elongated mat has a rectangular configuration. A symmetrical body placement guide is imprinted on the upper surface of the mat and configured to aid the yoga practitioner to properly align the practitioner's body during yoga postures. The body placement guide includes a patterned design defining a longitudinal axis which substantially extends the length and bisects the upper surface of the mat. The pattern design also defines a transverse axis bisecting the longitudinal axis. The longitudinal axis and transverse axis define four equal quadrants. Each quadrant is adjacent to two other quadrants. The pattern design in each quadrant is a mirror image of the pattern design of the two adjoining quadrants.

The pattern design typically includes indicia positioned from either the longitudinal or transverse axis at a forty-five degree angle. This indicia preferably comprises a line extending from either the longitudinal axis or transverse axis at the forty-five degree angle.

The patterned design may define multiple segments of equal area that are parallel to the transverse axis. The pattern design may also define multiple segments of equal area parallel to the longitudinal axis.

The patterned design includes step indicia within each quadrant. The step indicia may be created by intersecting lines that form a ninety degree angle.

The specification does not provide a description of the material which forms the layer or the thickness thereof. However, the specification states that the mat has an upper and a lower surface (Page 3) and the mat can vary in shape and size (Page 5). The specification principally focuses on the indica appearing on the upper surface of the mat and described in the figures of the application.

In general, a preamble limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). Conversely, a preamble is not limiting "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). Moreover, preambles describing the use of an invention generally do not limit the claims because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure. *In re Gardiner*, 171 F.2d 313, 315-16, 80 USPQ 99, 101 (CCPA 1948). "The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not." *Roberts v. Ryer*, 91 U.S. 150, 157 (1875).

In the instant case, the term "yoga" includes thousands of postures which can be performed on the mat. (Specification, page 2). The term "yoga" is not limited to particular movements or positions, sitting, standing or otherwise, which could alter the type of indicia or pattern used on the surface of the mat structure. (See the specification in its entirety). A practitioner can perform a body alignment or yoga movement based on the indicia or pattern on the mat already recited in the body of the claims. Thus, the preamble limitation "yoga" does not change the structure of the mat

recited in the body of the claims. With this understanding of the claimed invention, we will review the rejection under § 103.

Claims 1 and 3-23 are stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dionne. In the Office Action mailed May 14, 2003, page 3, the Examiner states:

Dionne discloses a mat (figure 1) having an upper surface (24) and a lower surface (20) and a symmetrical body placement guide (30) on the upper surface of the mat; a patterned design (col. 3, lines 66-67 thru col. 4, lines 1-22) defining a longitudinal axis substantially extending the length of and bisecting the upper surface and having a transverse axis bisecting the longitudinal axis and indicia comprising a line (40) positioned on the longitudinal axis at forty-five degree angles (figures 1, 3a-4b and 6-8); four equal quadrants (col. 4, line 23) defined by the longitudinal and transverse axes where the quadrants are adjacent and are a mirror image of adjoining adjacent quadrants (figures 1, 3a-4b and 6-8).

Appellant argues that Dionne is a non-analogous reference because Dionne's field of endeavor is golf while the field of endeavor of the instant application is yoga. (Brief, pp. 17-19; Reply Brief, filed February 11, 2004, pp. 9-11).

The Federal Circuit has delineated two indicia for indicating whether prior art references are analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the art is not within the same field of endeavor, whether it is reasonably pertinent to the particular problem to be solved. *In re Clay*, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *In re Wood*, 599

F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). In the present case, Dionne, like the present claims, describes a mat which comprises indicia on the upper surface. The indicia appearing on the surface of the mat allows the user to tract the movement made on the mat. Thus, we determine that the Dionne reference is analogous to the subject matter of the claimed invention. In any event, when the reference fully describes the claimed subject matter, the question of analogousness is not an issue. Cf. *In re Self*, 671 F.2d 1344, 1350-51, 213 USPQ 1, 7 (ccpa 1982).

Appellant argues that Dionne does not disclose an elongated mat, a symmetrical placement guide on the upper surface of the mat and indicia positioned from the longitudinal axis at a forty-five degree angle. (Brief, pp. 22-24). These arguments are not persuasive. Dionne's figure 8 describes a mat which is elongated and has the indicia required by the claims 1, 11 and 18.⁷ Appellant acknowledges (Brief, p. 24) that Dionne describes longitudinal and transverse axes defining four quadrants comprising a mirror image pattern. The pattern described in Dionne is a grid having secondary lines intersecting at a 90° angle. These points of intersection, like those of Appellant, occur at 45° from the intersection of the major longitudinal and transverse axes formed by the lines. Accordingly, this disclosure meets the limitations of claims 1, 11 and 18. Claims 1, 11 and 18 do not require that the indicia

⁷ Appellant acknowledges, Brief page 28, that Dionne figure 8 discloses a rectangular configuration.

positioned from the longitudinal and transverse axes extend beyond this point of intersection of the major axes.

Appellant argues that Dionne fails to describe a symmetrical body placement guide on the upper surface of the mat, which is configured to aid the yoga practitioner to properly align the body during yoga postures. (Reply Brief, pp. 14-16). We do not agree. The pattern on the mat of Dionne provides indicia which function as placement marks. These indicia allow a person utilizing the mat to measure or observe the body position. For example, a person stretching on the mat could reach for the intersection of the various lines of the grid pattern either inside of the same quadrant or in multiple quadrants, which allows for body alignment measurement.

Appellant has presented extensive arguments in the various Briefs regarding the use of the mat for performing yoga. Specifically, Appellant argues the distinction between golf and yoga movements and positions. These arguments are not persuasive since the term "yoga" appearing in the claims does not exclude the indicia or the structure of the mat described in Dionne.

The subject matter of claims 6, 7, 13, 14, 20 and 21 further defines the pattern on the upper surface of the mat as defining multiple segments of equal area parallel to either the longitudinal axis or the transverse axis. Appellant argues "[t]he interpretation of the grid 30 [of Dionne] as defining 'multiple segments' is not consistent with the specification." (Brief, p. 38). This argument is not persuasive. It is

not apparent how the areas created by the intersection of the longitudinal and transverse lines described in Dionne does not create multiple segments of equal area parallel to the longitudinal axis and/or the transverse axis. The rejection of these claims is affirmed.

The subject matter of claims 10 and 17 further defines the mat as having a rectangular configuration. Appellant argues that figure 8 discloses an octagonal mat having 8 sides. (Brief, pp. 40-41). This argument is not persuasive. As acknowledged by Appellant (Brief, p. 28), Dionne discloses that the shape of figure 8 is rectangular. (See col. 5).

The subject matter of claims 8, 9, 15, 16 and 22 further defines the step indicia pattern on the upper surface of the mat. Appellant's arguments regarding the subject matter of these claims are not persuasive. It is not apparent how the areas created by the intersection of the longitudinal and transverse lines described in Dionne does not create step indicia within each quadrant. In fact, the indicia described by claim 9 appear to be the same as the indicia described by Dionne. The rejection of these claims is affirmed.

The subject matter of claims 3, 5 and 19 requires a line extending from the intersection of the longitudinal and transverse axes at 45° angle. This line is not disclosed by Dionne and the Examiner has not provided motivation for adding such a line to the pattern on the mat of Dionne. The rejection of these claims is reversed.

The subject matter of claim 23 describes the pattern appearing on the upper surface of the mat as having a plurality of rectangles which are separated into six non-overlapping sets of four quadrants which define a unit area on opposing sides of said second center line wherein each set of said four quadrants has a center point surface of the mat as define multiple segments of equal area parallel to either the longitudinal axis or the transverse. These features are not disclosed by the pattern appearing on the surface of Dionne's mat. Thus, the rejection of this claim is reversed.

OTHER ISSUES

Prior to disposition of the present application the Examiner should object to claims 4, 5, 14 and 17 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The subject matter of claim 4 is the same as claim 1, the subject matter of claim 5 is the same as claim 3, the subject matter of claim 14 is the same as claim 13 and the subject matter of claim 17 is the same as claim 10.

CONCLUSION

For the foregoing reasons and those set forth in the Answer, giving due weight to Appellant' arguments, we determine that the preponderance of evidence weighs in favor of the Examiner's rejection of claims 1, 4, 6-18, 21 and 22 under § 103 and the rejection of claim 23 under § 112, first paragraph. The rejection of claims 3, 5, 19 and 23 under 35 U.S.C. § 103(a) is reversed.

The rejection of claim 23 under 35 U.S.C. § 112, first paragraph is affirmed.
The rejection of claims 1, 4, 6-18, 21 and 22 under 35 U.S.C. § 103(a) is affirmed.

TIME FOR TAKING ACTION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

Affirmed-in-Part

Bradley R Harris

BRADLEY R. GARRIS
Administrative Patent Judge


CHUNG K. PAK

Administrative Patent Judge


JEFFREY T. SMITH
Administrative Patent Judge

**JEFFREY T. SMITH
Administrative Patent Judge**

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